Paper No. 34

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte CRAIG HEIKES

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Appeal No. 1998-2598
Application No. 08/549,078

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ON BRIEF

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Before JERRY SMITH, FLEMING, and BLANKENSHIP, Administrative Patent Judges.

BLANKENSHIP, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-12, which are all the claims in the application.

We reverse.

BACKGROUND

The examiner relies on the following U.S. patents:

Widdoes, Jr. (Widdoes)	4,590,581	May 20, 1986
Butts et al. (Butts ‘231)	5,452,231	Sep. 19, 1995

Claims 1-12 stand rejected under 35 U.S.C. § 103 as being unpatentable over Butts ‘231 in view of Widdoes.

We refer to the Final Rejection (mailed Aug. 23, 1996) and the Examiner's Answer (mailed Apr. 22, 1997) for a statement of the examiner's position and to the Brief (filed Jan. 21, 1997) and the Reply Brief (filed June 18, 1997) for appellant’s position with respect to the claims which stand rejected.

The examiner has applied the teachings of Butts ‘231 in view of Widdoes against appellant’s claims. Appellant submits arguments on pages 20 through 56 of the Brief against the combination that has been proposed. Appellant submits separate arguments on pages 10 through 19 of the Brief with respect to why Butts ‘231 should not be considered prior art.

The instant application was filed on October 27, 1995. According to appellant, as set forth on page 1 of the Brief, the instant application is a continuation of application 08/173,730, filed Dec. 22, 1993, which in turn is a continuation of application 07/684,539, filed April 11, 1991. The effective filing date of the instant application is thus taken to be April 11, 1991.

According to information on the front page of Butts '231, the patent is a continuation of Ser. No. 923,361, filed Jul. 31, 1992, abandoned, which is a division of Ser. No. 698,734, filed May 10, 1991, abandoned, which is a continuation-in-part of Ser. No. 417,196, filed Oct. 4, 1989, U.S. Patent No. 5,036,473[1], which is a continuation-in-part of Ser. No. 254,463, filed Oct. 5, 1988, abandoned.

Appellant indicates (Brief at 14) that U.S. Patent 5,036,473 (hereinafter, Butts '473) "contains the disclosure" of Butts '231. Appellant further indicates (id. at 14-15) that application Ser. No. 254,463, of which Butts '473 is a continuation-in-part, is unavailable from the USPTO and has been placed on official search. Appellant contends that the earliest effective filing date that can be established for Butts '473 is Oct. 4, 1989. Appellant concludes that Butts '231 has been removed as a reference by an affidavit filed in the instant application, pursuant to 37 CFR § 1.131, which swears behind the date of Oct. 4, 1989.

The examiner responds (Brief, page 8):

> The application [Ser. No. 245,463] has now been found by the Office. The Examiner asserts that relevant sections of Pat. No. 5,452,231 [Butts '231] are sufficiently taught in Ser. No. 07/254,463. Therefore, in order for the Rule 131 Affidavit to be effective, the Appellant must swear behind the date of Oct.5, 1988.

[1] Although not indicated on the face of the Butts '231 patent, U.S. Patent 5,036,473 issued Jul. 30, 1991.

In the Reply Brief appellant asserts that he was not supplied with any portion of the application at issue, and maintains that the Rule 131 affidavit removes Butts '231 as a reference. The instant application was remanded by a Program and Resource Administrator of this Board (paper mailed Jul. 7, 2000) to indicate whether the Reply Brief had been entered, and, if entered, what effect the Reply Brief has on the pending rejections. In a communication mailed Sep. 13, 2000, the examiner stated that "[t]he reply brief filed 6/18/97 has been entered and considered. The application has been forwarded to the Board of Patent Appeals and Interferences for decision on the appeal."

OPINION

At the outset, we note that although the rejection is ostensibly based upon 35 U.S.C. § 103, it is more properly viewed as a 35 U.S.C. § § 102(e)/103 rejection. This is so because Butts '231 is considered to represent an invention described in "a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent." See 35 U.S.C. § 102(e)(2). If shown to be a reference under section 102, then the teachings of Butts '231 may be combined with other teachings (e.g., those of Widdoes, a reference under 35 U.S.C. § 102(b)), within the constraints of section 103, to establish prima facie obviousness of the instantly claimed subject matter.

However, for reasons set forth in In re Wertheim, 646 F.2d 527, 531-39, 209 USPQ 554, 559-66 (CCPA 1981), when a patent disclosure relies on one or more continuation-

in-part applications in a chain of priority under 35 U.S.C. § 120, there must be a determination with respect to what effect the presentation of new matter has in the patent's chain of priority -- whether the patent disclosure represents "secret prior art" as to the application at issue, and is thus not effective as a reference.

> If...[the USPTO] wishes to utilize against an applicant a part of that patent disclosure found in an application filed earlier than the date of the application which became the patent, it must demonstrate that the earlier-filed application contains §§120/112 support for the invention claimed in the reference patent.

Wertheim, 646 F.2d at 537, 209 USPQ at 564.

The determinative question is whether the invention claimed in the patent finds a supporting disclosure, in the patent's application in question, in compliance with section 112, as required by section 120, so at to entitle that invention as "prior art" to the filing date of the patent's application. See id. The only date a patent has under section 102(e)(2) is the filing date of the application on which the patent issued. "Any earlier U.S. filing date for the patent necessarily depends on further compliance with § § 120 and 112." Wertheim, 646 F.2d at 538, 209 USPQ at 565.

Thus, under 35 U.S.C. § 102(e)(2), the effective date of Butts '231 as a reference is May 17, 1994, the filing date of the application which matured into U.S. Patent 5,452,531. If we presume the patent's claims of priority under 35 U.S.C. § 120 to be correct, we can, without further evidence, presume that the effective filing date of Butts '231 is May 10,

1991; which, we note, is subsequent to applicant's claimed effective filing date of April 11, 1991.

The Butts '231 disclosure does not indicate the new matter that was introduced upon filing of the May 10, 1991 application. In any event, appellant recognizes that the disclosure of Butts '473 is prior art with respect to the effective (section 120) filing date of the instant application, and appears to accept that the disclosure of the applied Butts '231 patent could support a section 103 rejection to the same extent that the disclosure of Butts '473 could support a section 103 rejection. However, appellant challenges the premise that the effective filing date of Butts '231, or the effective filing date of Butts '473, extends beyond the filing date of the application which issued as U.S. Patent 5,036,473 -- Oct. 4, 1989.

The allocation of burdens requires that the USPTO produce the factual basis for its rejection of an application under 35 U.S.C. § § 102 and 103. In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984) (citing In re Warner, 379 F.2d 1011, 1016, 154 USPQ 173, 177 (CCPA 1967)). The one who bears the initial burden of presenting a prima facie case of unpatentability is the examiner. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Certain factual underpinnings, important in any obviousness inquiry -- the scope and content of the prior art -- have been challenged by appellant. Appellant's contesting of the findings with respect to the scope and content of the prior art, in combination with the fact that material is missing in the

present record -- the material necessary for reaching a definitive answer on the issue -- persuades us that the examiner has failed to set forth a prima facie case of unpatentability.

We speculate that, in many cases where the effective filing date of a patent containing continuation-in-part applications in the chain of priority is material to patentability, the examiner may make a rejection in view of the earliest possible, but unproven, effective filing date. An applicant may then, in preparing a response, obtain a copy of the relevant application and decide whether alleging lack of section 112 support for the patented invention would be appropriate.

We are sympathetic to the examiner's plight in apparently not being able to possess the relevant patent application until late in prosecution. However, the burden of producing evidence of prima facie unpatentability falls on the examiner. If the relevant evidence cannot be produced, the allocation of burdens requires that the inference resulting from the lack of production must be construed in an applicant's favor.

On the other hand, we are also sympathetic to appellant's plight in attempting to respond to a rejection without being presented with the evidence in support thereof. The instant situation is, by analogy, similar to using the teachings of some reference not obtainable by appellant, with the examiner setting forth unrebuttable presumptions with respect to what the reference teaches. The Answer's terse allegation that "relevant sections" of Butts '231 "are sufficiently taught" in the relevant patent application need not be accepted at face value by appellant. Moreover, for all the allegation states, an

improper legal standard may have been applied. As required by Wertheim, there must be section 112 support for the patented invention, rather than simple determination that the material now supporting a rejection was present in the relevant application.

According to current USPTO computerized records, the application in question, Ser. No. 07/254,463 was refiled (as a file wrapper continuation) as application 07/474,675. The records show that the status of application 07/474,674, which presumably contains the file wrapper of Ser. No. 07/254,463, is "Lost." Even if we could obtain Ser. No. 07/254,463 and make requisite factual findings, in the first instance, with respect to the question of section 112 support of the invention of Butts '231 (or Butts '473), it would not be proper for us to do so. Appellant must have the opportunity to respond to any factual findings in support of a rejection. Moreover, the requisite factual findings, in the first instance, should be made by one who is familiar with the lexicon of the relevant art.

We are left with the question of proper disposition of the instant application: to remand the application for further prosecution before the examiner, or to reverse the rejection before us. We think reversal is the best course of action because the evidence relied on -- which is lacking in the showing of the scope and content of the prior art -- is insufficient to support a case of prima facie obviousness. Whether Butts '231 is a reference depends upon the subject matter described in application 07/254,463; it may well be the case that Butts '231 can only be "secret prior art" with respect to the instant invention.

However, the examiner should consider anew whether Butts ‘231 is a reference, in light of our determinations set forth in this opinion. Any rejection under 35 U.S.C. § § 102/103 which uses Butts ‘231 as a reference, and which asserts that the effective filing date of Butts ‘231 is Oct. 5, 1998, must be supplemented by pointing out section 112 support in Ser. No. 07/254,463 for the patented invention of Butts ‘231. Any rejection under 35 U.S.C. § § 102/103 which uses Butts ‘473 as a reference, and which asserts that the effective filing date of Butts ‘473 is Oct. 5, 1998, must be supplemented by pointing out section 112 support in Ser. No. 07/254,463 for the patented invention of Butts ‘473.

CONCLUSION

The rejection of claims 1-12 is reversed.

REVERSED

JERRY SMITH Administrative Patent Judge	)))))) BOARD OF PATENT
MICHAEL R. FLEMING Administrative Patent Judge	) APPEALS) AND) INTERFERENCES
HOWARD B. BLANKENSHIP Administrative Patent Judge	)))))

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